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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,758	04/11/2001	William M. Jackson	82515RLO	3362

7590 06/20/2005

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EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/832,758

Applicant(s)

JACKSON ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-17, 22-26 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-17, 22-26 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Response to Amendment**

1. Applicant's arguments with respect to claim 1-7,14-17,22-26 and 31-33 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues on page 8 lines 6 that Safai et al is not concern with ordering a selected photo products, Examiner disagrees and points out column 15 lines 27-57 where the photo album is ordered and prepared and also on lines 46-58 where the other product could be ordered like T-shirts and coffee mugs.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim1-7, 14-17,22-26 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al (U.S. patent 6,167,469) in view of Zehr et al (Pub.No.: US 20010025274)

Regarding claim 1 and 22 Safai et al disclose: A method of ordering a photo product to be printed at a selected location and delivered to a designee comprising the steps of: (a) a user communicating with a service provider (please note Fig.6 item 100 the camera and item 602, column 13 lines 10 24 where the user pushes the button to send photos from the camera to the service provider 602) that offers a plurality of photo products and selecting a particular photo product to incorporate a digital image provided by the user (please note Fig.6 item 602 where the product selected by the user like

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photo album or any product, column 15 lines 14-45) (b) the user providing an identification of the designee's location where the selected photo product is to be delivered (please note Fig.4E &F, column 12 lines 3-35) and also Fig.6 column 13 lines 66-67 and column 14 lines 1-25). However Safai et al do not disclose: (c) the service provider automatically selecting from a plurality of remote printing locations a particular printing location based on the identification of the designee's location (d) using a communications network to transfer the digital image from the user to the particular printing location and (e) printing the selected photo product at the particular printing location and delivering the photo product to the designee. On the other hand Zehr et al disclose: (c) the service provider automatically selecting from a plurality of remote printing locations a particular printing location based on the identification of the designee's location (please note Fig.2 item 44 and LPFs where the designated mails with the specific addresses are send to the certain LPF for proximity purposes, pages 2&3, paragraph 0032) (d) using a communications network to transfer the digital image from the user to the particular printing location (please note page 2 paragraph 0031) and (e) printing the selected photo product at the particular printing location and delivering the photo product to the designee (please note pages 2&3, paragraphs 0031 and 0032, also note paragraph 0048 on page 5). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al's invention according to the teaching of Zehr et al, where Zehr et al in the same filed of endeavor teach the way the addresses of the recipients or designees are being processed. Zehr teaches the received recipient mail address by the Safai would be

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send through the network with images to be printed remotely in proximity of the recipient(s).

Regarding claim 2 Safai et al disclose: The method of claim 1 wherein the user makes payment via the network for the photo product (please note column 15 lines 19-26).

Regarding claim 3 and 25 Zehr et al disclose: The method of claim 1 wherein the identification of the designee's location is the designee's zip code (please note page 3 paragraph 0035 lines 5-8).

Regarding claim 4 and 26 and Zehr et al disclose: The method of claim 3 wherein the photo product is delivered to the designee by the U.S. postal service (please note page 2 paragraph 0031).

Regarding claim 5 Zehr et al disclose: The method of claim 1 wherein the service provider communicates a network address of the particular printing location to the user (please note page 3 paragraph 0032).

Regarding claim 6 Safai et al disclose: The method of claim 5 wherein the user transfers the digital image to the network address communicated by the service provider (please note column 13 lines 66-67 and column 14 lines 1-25).

Regarding claim 7 Safai et al disclose: The method of claim 1 wherein the photo product includes at least one album page (please note column 15 lines 27-30) the digital image is transferred from the user directly to the particular printing locations and album page background image data is communicated from the service provider to the

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particular printing location in order to produce the at least one album page (please note column 15 lines 31-45).

Regarding claim 23 Safai et al disclose: The method of claim 22 wherein step (f) includes printing a postage stamp on the shipping label (please note column 14 lines 38-42).

Regarding claim 24 Safai et al disclose: The method of claim 23 wherein the postage stamp depicts at least a portion of the digital image (please note column 14 lines 35-44).

Regarding claim 31 and 33 Safai et al disclose: wherein different remote location can print different photo products and the service provider selects the printing location from the plurality of printing location which are capable of printing the user selected product (note Fig.6 column 15 lines 48-54 where the printing product is selected and printed over the network as Zehr has taught).

Regarding claim 14 Safai et al disclose: A method of ordering a photo product to be printed at a selected location and delivered to a designee, comprising the steps of: (a) a user communicating with a service provider that offers a plurality of photo products and selecting a particular photo product to incorporate a plurality of digital images provided by the user (please note Fig.6 item 100 the camera and item 602, column 13 lines 10 24 where the user pushes the button to send photos from the camera to the service provider 602 and also note Fig.6 item 602 where the product selected by the user like photo album or any product, column 15 lines 14-45) (b) the service provider producing a representation of the photo product and sending such representation to the

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user (please note Fig.6, column 15 lines 27-45 where the service provider 602 provides virtual photo album services to the user) (c) the user approving an order for the photo product depicted in said representation (please note column 15 lines 46-57) and providing an identification of the designee's location where the selected photo product is to be delivered and providing an identification of the designee's location where the selected photo product is to be delivered (please note Fig.6 column 13 lines 66-67 and column 14 lines 1-25) However Safai et al do not disclose: (d) the service provider using said identification of the designee's location to select from a plurality of printing locations a particular printing location (e) using a communications network to transfer the plurality of digital images to the particular printing location; and (f) printing the selected photo product at the particular printing location and delivering the photo product to the designee. On the other hand Zehr et al disclose: (d) the service provider using said identification of the designee's location to select from a plurality of remote printing locations a particular printing location (please note Fig.2 item 44 and LPFs where the designated mails with the specific addresses are sent to the certain LPF for proximity purposes, pages 2&3, paragraph 0032) (e) using a communications network to transfer the plurality of digital images to the particular printing location (please note page 2 paragraph 0031) and (f) printing the selected photo product at the particular printing location and delivering the photo product to the designee (please note pages 2&3, paragraphs 0031 and 0032, also note paragraph 0048 on page 5). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al's invention according to the teaching of Zehr et al, where Zehr et al in

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the same filed of endeavor teach the way the addresses of the recipients or designees are being processed. Zehr teaches the received recipient mail address by the Safai would be send through the network with images to be printed remotely in proximity of the recipient(s).

Regarding claim 15 Safai et al disclose: The method of claim 14 wherein the plurality of photo products is selected from a group including an album page containing two or more digital images provided by the user (please note column 15 lines 27-35).

Regarding claim 16 Safai et al disclose: The method of claim 14 wherein the plurality of photo products includes prints having a plurality of different sizes (please note column 10 lines 32-35).

Regarding claim 17 Safai et al disclose: The method of claim 14 further including the steps of a user providing a payment identifier specifying an account to be charged for producing and delivering the photo product (please note column 15 lines 16-25).

Regarding claim 32 Safai et al disclose: wherein different remote location can print different photo products and the service provider selects the printing location from the plurality of printing location which are capable of printing the user selected product (note Fig.6 column 15 lines 48-54 where the printing product is selected and printed over the network as Zehr has taught).

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

#### **Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

#### **Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for *formal* communications; please mark  
"EXPEDITED PROCEDURE")

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Or:

(703) 306-5406 (for *informal* or *draft* communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Knox building on 501 Dulany  
Street, Alexandria, VA.

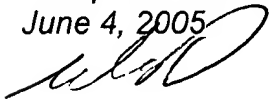
Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group Receptionist whose telephone number is (703) 305-4750.


Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

June 4, 2005



  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER